

### REMARKS

Applicant has reviewed and considered the Office Action mailed on January 14, 2004, and the references cited therewith.

Claims 57, 64, 69, 81, and 96 are amended. Claims 65, 70, 71, 77, 82, 86, and 88 are canceled without prejudice or disclaimer. New claims 99-116 are added. Claims 57-64, 66-69, 72-76, 78-81, 83-85, 87, and 89-116 are now pending in this application.

#### §112 Rejection of the Claims

Claims 69-80, 86 and 88 were rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement.

#### *Claims 69-80*

Claim 69 was amended to more clearly describe the recited subject matter, particularly the recited multi-durometer construction. Applicant believes that the amendment has addressed the issue raised in the Office Action with respect to the scope of the multi-durometer in claims 69-80.

Applicant respectfully requests reconsideration and allowance of claims 69-80.

#### *Claim 70, 71, 86, and 88*

Claims 70, 71, 86, and 88 were canceled without prejudice or disclaimer. Applicant reserves the right to claim the subject matter recited in claims 70, 71, 86, and 88 in a continuation application.

#### References to “saline solution” in §102 and §103 Rejections

In several rejections under 35 USC § 102 and § 103, the Office Action asserts that Durand et al. (U.S. Patent No. 3,893,451, hereinafter “Durand”) “has a pressure transmitting catheter having a lumen filled with a saline solution” and “uses a saline solution as the pressure transmitting medium.” However, Applicant is unable to find in Durand the “saline solution.” Clarification of the rejection based on this assertion is respectfully requested in the next official action, or withdrawal of this assertion is believed appropriate.

*§102 Rejection of the Claims*

Claims 57, 63, 64, and 66 were rejected under 35 USC § 102(b) as being anticipated by Durand.

*Claim 57*

Claim 57 was amended to better describe the recited subject matter. Insofar as the rejection is applied to claim 57, Applicant respectfully traverses the rejection. Applicant submits that Durand does not provide the subject matter recited in claim 57. For example, Applicant is unable to find that Durand teaches or suggests the implantable housing holding the signal processing circuitry and the transducer, as recited in claim 57.

Additionally, the Office Action asserts that “it is inherent that such instrument has a housing containing both a transducer and signal processing circuitry for processing the transducer output.” Applicant respectfully traverses this assertion as a form of Official Notice for stating what is inherent without support of a reference. Applicant timely traverses this assertion pursuant to M.P.E.P. §2144.03 and requests a reference to support the assertion or an affidavit of personal knowledge by the Examiner. Clarification of the rejection based on this assertion is respectfully requested in the next official action, or withdrawal of the rejection is believed appropriate.

Applicant respectfully requests reconsideration and allowance of claim 57.

*Claim 63*

Applicant respectfully traverses the rejection of claim 63. Claim 63 is dependent on claim 57. Thus, the discussion above for claim 57 is incorporated herein to support the patentability of claim 63.

Applicant respectfully requests reconsideration and allowance of claim 63.

*Claim 64*

Claim 64 was amended to better describe the recited subject matter. Insofar as the rejection is applied to claim 64, Applicant respectfully traverses the rejection. Applicant submits that Durand does not provide the subject matter recited in claim 64. For example, Applicant is

unable to find that Durand teaches or suggests the implantable housing for holding the signal processing circuitry and transducer, as recited in claim 64.

Additionally, the Office Action asserts that "it is inherent that such instrument has a housing containing both a transducer and signal processing circuitry for processing the transducer output." Applicant respectfully traverses this assertion as a form of Official Notice for stating what is inherent without support of a reference. Applicant timely traverses this assertion pursuant to M.P.E.P §2144.03 and requests a reference to support the assertion or an affidavit of personal knowledge by the Examiner. Clarification of the rejection based on this assertion is respectfully requested in the next official action, or withdrawal of the rejection is believed appropriate.

Applicant respectfully requests reconsideration and allowance of claim 64.

#### *Claim 66*

Applicant respectfully traverses the rejection of claim 66. Claim 66 is dependent on claim 64. Thus, the discussion above for claim 64 is incorporated herein to support the patentability of claim 66.

Applicant respectfully requests reconsideration and allowance of claim 66.

#### *§103 Rejection of the Claims Using Durand and Iwata*

Claims 58, 60, and 81 were rejected under 35 USC § 103(a) as being unpatentable over Durand in view of Iwata et al. (U.S. Patent No. 6,019,728, hereinafter Iwata).

#### *Claims 58 and 60*

Applicant respectfully traverses the rejection of claims 58 and 60. Claims 58 and 60 are dependent on claim 57. Thus, the discussion above for claim 57 is incorporated herein to support the patentability of claims 58 and 60.

Applicant respectfully requests reconsideration and allowance of claims 58 and 60.

### *Claims 81*

Claim 81 was amended to better describe the recited subject matter. Insofar as the rejection is applied to claim 81, Applicant respectfully traverses the rejection. Applicant submits that the proposed combination of references does not provide the subject matter recited in claim 81. For example, Applicant is unable to find that Durand and Iwata, each alone or in combination, teach or suggest, among other things, the implantable transducer housing to contain the transducer, as recited in claim 81.

Applicant respectfully requests reconsideration and allowance of claim 81.

### *§103 Rejection of the Claims Using Durand and Brockway*

Claims 59, 61, 62, 67 and 68 were rejected under 35 USC § 103(a) as being unpatentable over Durand in view of Brockway et al. (U.S. Patent No. 4,846,191, hereinafter Brockway).

### *Claim 59*

Applicant respectfully traverses the rejection of claim 59. Claim 59 is dependent on claim 57. Thus, the discussion above for claim 57 is incorporated herein to support the patentability of claim 59.

Applicant respectfully requests reconsideration and allowance of claim 59.

### *Claims 61 and 62*

Applicant respectfully traverses the rejection of claims 61 and 62. Claims 61 and 62 are dependent on claim 57. Thus, the discussion above for claim 57 is incorporated herein to support the patentability of claims 61 and 62.

Applicant further submits that the Office Action has not set forth a proper *prima facie* case of obviousness. Pursuant to M.P.E.P. § 2143.01, the fact that references can be combined or modified does not render the resultant combination or modification obvious unless the prior art also suggests the desirability of the combination or modification. For example, Applicant is unable to find in Durand and Brockway, among other things, a suggestion or motivation to modify the pressure transmission device of Durand to include the telemetry circuitry recited in claims 61 and 62. Thus, it is believed that the proposed combination of references fails to

suggest the desirability of such modification, and is therefore not a proper basis for an obviousness rejection.

The Office Action asserts:

Such a set up allows for long term monitoring of a patient without a nurse being at bedside as well as keeps the bedside free of wires. Hence, it would have been obvious to modify Durand et al to use a wireless telemeter, to allow for improved monitoring of the patient.”

Applicant respectfully traverses this assertion as a form of Official Notice for stating what would have been obvious without support of a reference. Applicant timely traverses this assertion pursuant to M.P.E.P §2144.03 and requests a reference to support the assertion or an affidavit of personal knowledge by the Examiner. Clarification of the rejection based on this assertion is respectfully requested in the next official action, or withdrawal of the rejection is believed appropriate.

Applicant respectfully requests reconsideration and allowance of claims 61 and 62.

#### *Claims 67 and 68*

Applicant respectfully traverses the rejection of claims 67 and 68. Claims 67 and 68 are dependent on claim 64. Thus, the discussion above for claim 64 is incorporated herein to support the patentability of claims 67 and 68.

Applicant further submits that the Office Action has not set forth a proper *prima facie* case of obviousness. For example, Applicant is unable to find in Durand and Brockway, among other things, a suggestion or motivation to modify the pressure transmission device of Durand to include the telemetry circuitry recited in claims 67 and 68. Thus, it is believed that the proposed combination of references fails to suggest the desirability of such modification, and is therefore not a proper basis for an obviousness rejection.

The Office Action asserts:

Such a set up allows for long term monitoring of a patient without a nurse being at bedside as well as keeps the bedside free of wires. Hence, it would have been obvious to modify Durand et al to use a wireless telemeter, to allow for improved monitoring of the patient.”

Applicant respectfully traverses this assertion as a form of Official Notice for stating what would have been obvious without support of a reference. Applicant timely traverses this assertion pursuant to M.P.E.P §2144.03 and requests a reference to support the assertion or an affidavit of personal knowledge by the Examiner. Clarification of the rejection based on this assertion is

respectfully requested in the next official action, or withdrawal of the rejection is believed appropriate.

Applicant respectfully requests reconsideration and allowance of claims 67 and 68.

§103 Rejection of the Claims Using Durand, Iwata, and Brockway

Claims 83, 84, and 96-98 were rejected under 35 USC § 103(a) as being unpatentable over Durand in view of Iwata and Brockway.

*Claims 83 and 84*

Applicant respectfully traverses the rejection of claims 83 and 84. Claims 83 and 84 are dependent on claim 81. Thus, the discussion above for claim 81 is incorporated herein to support the patentability of claims 83 and 84.

Applicant further submits that the Office Action has not set forth a proper *prima facie* case of obviousness. For example, Applicant is unable to find in Durand, Iwata, and Brockway, among other things, a suggestion or motivation to modify the pressure transmission device of Durand to include the telemetry circuitry recited in claims 83 and 84. Thus, it is believed that the proposed combination of references fails to suggest the desirability of such modification, and is therefore not a proper basis for an obviousness rejection.

The Office Action asserts:

Such a set up allows for long term monitoring of a patient without a nurse being at bedside as well as keeps the bedside free of wires. Hence, it would have been obvious to modify the above combination to use a wireless telemeter, to allow for improved monitoring of the patient.”

Applicant respectfully traverses this assertion as a form of Official Notice for stating what would have been obvious without support of a reference. Applicant timely traverses this assertion pursuant to M.P.E.P §2144.03 and requests a reference to support the assertion or an affidavit of personal knowledge by the Examiner. Clarification of the rejection based on this assertion is respectfully requested in the next official action, or withdrawal of the rejection is believed appropriate.

Applicant respectfully requests reconsideration and allowance of claims 83 and 84.

*Claim 96*

Claim 96 was amended to better describe the recited subject matter. Insofar as the rejection is applied to claim 96, Applicant respectfully traverses the rejection. Applicant submits that the proposed combination of references does not provide the subject matter recited in claim 96. For example, Applicant is unable to find that Durand, Iwata, and Brockway, each alone or in combination, teach or suggest, among other things, the implantable housing holding the signal processing and telemetry circuitry and transducer, as recited in claim 96.

Applicant respectfully requests reconsideration and allowance of claim 81.

*Claims 97*

Applicant respectfully traverses the rejection of claim 97. Claim 97 is dependent on claim 96. Thus, the discussion above for claim 96 is incorporated herein to support the patentability of claim 97.

Applicant further submits that the proposed combination of references does not provide the subject matter recited in claim 97. For example, Applicant is unable to find that Durand, Iwata, and Brockway, each alone or in combination, teach or suggest, among other things, the pressure transmission catheter having a length in the range from approximately two millimeters to approximately four centimeters, as recited in claim 97.

Applicant respectfully requests reconsideration and allowance of claim 97.

*Claims 98*

Applicant respectfully traverses the rejection of claim 98. Claim 98 is dependent on claim 96. Thus, the discussion above for claim 96 is incorporated herein to support the patentability of claim 98.

Applicant further submits that the Office Action has not set forth a proper *prima facie* case of obviousness. For example, Applicant is unable to find in Durand, Iwata, and Brockway, among other things, a suggestion or motivation to modify the pressure transmission device of Durand to include the telemetry circuitry recited in claim 98. Thus, it is believed that the

proposed combination of references fails to suggest the desirability of such modification, and is therefore not a proper basis for an obviousness rejection.

The Office Action asserts:

Such a set up allows for long term monitoring of a patient without a nurse being at bedside as well as keeps the bedside free of wires. Hence, it would have been obvious to modify the above combination to use a wireless telemeter, to allow for improved monitoring of the patient.”

Applicant respectfully traverses this assertion as a form of Official Notice for stating what would have been obvious without support of a reference. Applicant timely traverses this assertion pursuant to M.P.E.P §2144.03 and requests a reference to support the assertion or an affidavit of personal knowledge by the Examiner. Clarification of the rejection based on this assertion is respectfully requested in the next official action, or withdrawal of the rejection is believed appropriate.

Applicant respectfully requests reconsideration and allowance of claim 98.

*§103 Rejection of the Claims Using Durand and Pohndorf*

Claims 85-88 were rejected under 35 USC § 103(a) as being unpatentable over Durand in view of Pohndorf et al. (U.S. Patent No. 5,353,800, hereinafter Pohndorf).

*Claims 85-88*

Applicant respectfully traverses the rejection of claims 85-88. Claims 85-88 are dependent on claim 81. Thus, the discussion above for claim 81 is incorporated herein to support the patentability of claims 85-88.

Applicant respectfully requests reconsideration and allowance of claims 85-88.

*§103 Rejection of the Claims Using Durand, Pohndorf, and Brockway*

Claims 89 and 90 were rejected under 35 USC § 103(a) as being unpatentable over Durand in view of Pohndorf, as applied to claims 85-88 above, further in view of Brockway.



*Claims 89 and 90*

Applicant respectfully traverses the rejection of claims 89 and 90. Claims 89 and 90 are dependent on claim 81. Thus, the discussion above for claim 81 is incorporated herein to support the patentability of claims 89 and 90.

Applicant further submits that the Office Action has not set forth a proper *prima facie* case of obviousness. For example, Applicant is unable to find in Durand, Pohndorf, and Brockway, among other things, a suggestion or motivation to modify the pressure transmission device of Durand to include the telemetry circuitry recited in claims 89 and 90. Thus, it is believed that the proposed combination of references fails to suggest the desirability of such modification, and is therefore not a proper basis for an obviousness rejection.

The Office Action asserts:

Such a set up allows for long term monitoring of a patient without a nurse being at bedside as well as keeps the bedside free of wires. Hence, it would have been obvious to modify the above combination to use a wireless telemeter, to allow for improved monitoring of the patient.”

Applicant respectfully traverses this assertion as a form of Official Notice for stating what would have been obvious without support of a reference. Applicant timely traverses this assertion pursuant to M.P.E.P §2144.03 and requests a reference to support the assertion or an affidavit of personal knowledge by the Examiner. Clarification of the rejection based on this assertion is respectfully requested in the next official action, or withdrawal of the rejection is believed appropriate.

Applicant respectfully requests reconsideration and allowance of claims 89 and 90.

*Allowable Subject Matter*

Applicant acknowledges the allowance of claims 91-95.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6912 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,

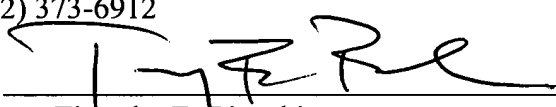
BRIAN P. BROCKWAY ET AL.

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Date April 14, 2004

By

  
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 14 day of April, 2004.

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